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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/061,755	02/01/2002	Brandon James Shuman	1759-17-3	2908
20995	7590	06/23/2004	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP			SAM, CHARLES H	
2040 MAIN STREET			ART UNIT	
FOURTEENTH FLOOR			PAPER NUMBER	
IRVINE, CA 92614			3731	

DATE MAILED: 06/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/061,755

Applicant(s)

SHUMAN, BRANDON JAMES

Examiner

Charles H. Sam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15-18 is/are allowed.
- 6) ☒ Claim(s) 1-14 and 16-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3,5-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Wagner (5,147,369). Wagner discloses the invention as claimed comprising a first structure 52 including a first circumferential surface, and a second structure 54 including a second circumferential surface corresponding to the first circumferential surface. Figure 2 shows the structures aligned at the distal end.

Regarding claims 2, Wagner discloses a biasing element (42,44,46) coupled to the first structure 52 and the second structure 54. Figure 2 shows the structures aligned at the distal end.

Regarding claim 3, Wagner discloses the biasing element (42,44,46) that brings the first and second circumferential surfaces together with sufficient force.

Regarding claim 5, Wagner discloses the first circumferential surface of the first structure 52 includes a cutting edge 60, and the second circumferential surface of the second structure 54 includes a cutting edge 62.

Regarding claim 6, Wagner discloses a biasing element (42,44,46) coupled to the first structure 52 and the second structure 54.

Regarding claim 7, Wagner discloses the first circumferential surface of the first structure 52 includes a cutting edge 60, and the second circumferential surface of the second structure 54 includes a cutting edge 62.

Regarding claim 8, Wagner discloses when the first and second circumferential surfaces are brought together the first structure 52 and the second structure 54 define a chamber (56,58).

Claims 1,2,4,22, and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Domino. Domino discloses a surgical device 50 comprising a first structure 54 having a first aperture 62, and a second structure 56 having a second aperture 62.

Claims 13 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Pearl (5,207,702). Pearl discloses a handling device comprising a first structure 18 including a first partial circumferential surface 54, a second structure 20 including a second partial circumferential surface 56, and a bias element configured to bring the circumferential surfaces of the first and second structures toward each other.

Claim 19 rejected under 35 U.S.C. 102(b) as being anticipated by Shallman (5,693,069). Shallman discloses a tissue removing device comprising a confining means having two circumferential surfaces 28 of tips 22, and means 42 having engaging means 44 for maintaining the circumferential surfaces 28 together.

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22-24,26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner (5,147,369) in view Pearl (5,207,702). Wagner discloses the invention as claimed except for a biasing element configured to bias the first and second engaging portions together. However, Pearl teaches a biasing element at proximal ends 30,32 for holding the distal ends 18,20 together. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to modify Wagner by including a biasing element in view of Pearl. A biasing element would allow Wagner's device to grip tissue upon release of the device.

Allowable Subject Matter

Claims 15-18 are allowed.

None of the prior art of record, alone or in combination, discloses a method of isolating deleterious body tissue located within healthy body tissue by limiting blood and fluid communication with the deleterious body tissue as set forth in claims 15-18.

Response to the Applicants Remarks

The applicants arguments filed on 3/25/04 have been fully considered but they are not deemed to be persuasive. The examiner disagrees with the applicants arguments concerning Wagner's reference because Wagner teaches every structural limitations recited by the claim. Thus, Wagner appears to be a proper reference for the

rejections. Concerning claims 2 and 13, the examiner respectfully disagrees with the applicants arguments; see the rejections of claims 2 and 13 above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles H. Sam whose telephone number is (703) 305-5650. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, McDermott or Shaver can be reached on (703) 308-0858. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

chs

chs

June 7, 2004

Julian W. Woo

JULIAN W. WOO
PRIMARY EXAMINER